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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,711	11/12/2003	Guillaume Cassin	LOREAL 3.0-046; OA02360/E	9477
530 7590 12/28/2009 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER FUBARA, BLESSING M				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,711

Applicant(s)

CASSIN, GUILLAUME

Examiner

BLESSING M. FUBARA

Art Unit

1618

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 8-14, 16-23, 25-35 and 37-46 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 14, 16-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8-13, 23, 25-35 and 37-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Examiner acknowledges receipt of supplemental response filed 10/22/09; request for continued examination under 37 CFR 1.114, amendment and remarks filed 10/15/09. Claims 1, 8, 16 and 33 are amended. Claims 4, 5 and 15 are canceled. Claims 1, 3, 8-14, 16-23, 25-35, 37-46 are pending and of these, claims 3 and 14-22 are withdrawn from consideration.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/09 has been entered.

Response to Arguments

Previous rejections that are not reiterated herein are withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 8-13, 23, 25-35 and 37-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1 and 33 contain the trademark/trade name POLYSILICONE-8. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe grafted silicone polymer, which is a polydimethylsiloxane onto which are grafted, via a linking chain of thiopropylene type, mixed polymer units of the poly(meth)acrylic acid type and of the polyalkyl (meth)acrylate type such as 3-Thiopropyl methyl siloxane, polymer with dimethylsiloxane, S-ester with polymer of 2-propenoic acid and methyl 2-methyl-2-propenoate and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 8-13, 23, 25-35 and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubief et al. (US 6, 090,376) in view of Nandagiri et al. (US 5,362,486).
7. Dubief discloses composition comprising at least one grafted silicone polymer in particle form dispersed in aqueous medium, amphiphilic polymer (abstract; column 1, lines 32-43; column 2, lines 21-27; column 5, lines 28-30; column 7, lines 5-7), water (column 6, line 64), vegetable, animal or synthetic oils or vitamins or surfactants (column 7, lines 8-13). The composition comprising the amphiphilic polymer, the grafted silicone is a tensioning polymer. The amphiphilic polymer is used in amounts of between 0.01 to 20 wt% (column 6, lines 59-62) and the amphiphilic polymer can be based on acrylic polymers (column 5, line 60 to column 6, line 56) with the acrylic polymers meeting claim 8-13. Exhibiting "a retraction of isolated stratum corneum ... in water is a property/characteristic of the tensioning polymer and the tensioning polymer of Dubief would have the same property/characteristic. Claim 1 requires that the surfactant be present at amounts of less than 1% by weight relative to the total composition and the suggestion by Dubief that the additive surfactant be present at amounts of 0-20, with the lower limit of 0 being less than 1% suggestive that an amount of less than 1% can be used so that that limitation brought from original claim 24 into claim 1 is met. The requirement that the surfactant be different from the amphiphilic polymer is also met because, Dubief discloses composition containing amphiphilic polymer, surfactant.
8. Claims 11, 12 and 23, 25-32 recite the amounts of the acrylic polymer/ionic amphiphilic polymer, tensioning polymer, fatty phase, surfactant and water. Dubief does not teach the exact

amounts recited in those claims. The amount of the ionic amphiphilic polymer of Dubief at 0.01 to 20 wt% (column 6, lines 59-62) encompasses the claimed amount of the ionic amphiphilic polymer or acrylic polymer.

9. Dubief discloses composition comprising ionic amphiphilic polymer, tensioning polymer, water and oil as described above. The composition of Dubief is applied to the hair for treatment (abstract). The tensioning polymer of Dubief is a grafted silicone interpenetrating polymer as stated above. Dubief does not teach polyurethane and polyacrylic as tensioning polymer as recited in amended claim 1 as one of the choices for the polymer. However, Nandagiri discloses composition comprising polyurethane-acrylate for bodifying hair (column 15, lines 13-62). Therefore, taking the two references together, it would have been obvious to use the polyurethane-acrylate tensioning interpenetrating polymer of Nandagiri in the composition of Dubief and expect to have a composition for treating hair as it relates to body, feel, styling and disentangling of the hair.

10. While Dubief suggests the use of additive surfactant polymer at 0-20%, Dubief does not specifically relate the amount of the surfactant to the total weight of the composition, and while these amounts are not exactly the same as those recited in the claims, the amounts recited in the claims would have been obvious because the person of ordinary skill in the art would have good reason to use various components of the composition in amounts that would provide composition that when applied to hair would effectively treat the hair as regards entangling/disentangling and smoothness and styling and feel. In the absence of unexpected results, the amounts recited in those claims are not inventive over the teaching of Dubief.

11. Claims 1 and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubief et al. (US 6, 090,376)) in view of Nandagiri et al. (US 5,362,486) and further in view of Bara (US 20020193513 A1).

12. Dubief uses composition containing grafted silicone to treat hair or keratinous substances (abstract) as described above. Nandagiri is relied upon for teaching composition containing poly-urethane acrylate for bodifying hair as described above, so that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the tensioning polymer of Nandagiri in place of the tensioning grafted silicone polymer of Dubief with the expectation that the modified composition would successfully bodify hair. Thus, the combined composition would also be used to treat hair or keratinous substances. However, while the combined composition is used to treat hair and bodify the hair, the combined teaching of Dubief and Nandagiri does not teach the limitations of claim 43.

13. But compositions containing polyacrylic acid or polyurethane polymers are known to provide tautness, slipperiness to the skins which does not dry out the skin (see the abstract; paragraphs [0010], [0058], [0059] and [0061] and claims 1, 16 and 19). The capability of providing tautness out irregularities of the skin such as wrinkles and fine lines according to Bara (abstract; paragraphs [0010], [0058], [0059] and [0061] and claims 1, 16 and 19).

14. Therefore, taking the teachings of Dubief and Nandagiri in view of Bara, one having ordinary skill in the art at the time the invention was made would reasonably expect that the application of the composition of Dubief and Nandagiri would effectively provide the anticipated tautness to the skin while smoothening the ski.

Response to Arguments

15. Applicant's arguments filed 10/15/09 and 10/22/09 have been fully considered but they are not persuasive.

16. Applicant says that amendment to claims 1 and 33 where polysilicone-8 is recited overcomes the Dubief art.

17. While examiner agrees that Dubief does not teach the polysilicone-8, the examiner also notes that Markush claim language is used to limit the tensioning polymers. Polysilicone-8 is one of the polymers used in the composition of claims 1 and 33 and the prior art only has to teach any of the other polymers in the Markush group to meet the limitation of claims 1 and 33. Therefore, while Dubief does not teach polysilicone-8, a secondary reference is used to show another tensioning polymer can be used in place of the silicone to achieve the desired effect.

Double Patenting

18. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

19. Claims 1, 6-13, 23, 25-35 and 37-46 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 10/982,925. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims and the co-pending claims are concerned with compositions containing amphiphilic polymer, tensioning polymer, aqueous phase and oil phase for treating keratinous substances and for treating skin conditions.

20. Claims 1, 6-13, 23, 25-35 and 37-46 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 60-116 and of U.S. Patent No. and 1-59 of copending Application Nos. 10/591,583 and 10/573,579 respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because the acrylates of the 10/591,583 and 10/573,579 applications are homologs of the acrylates of the examined claims; with the compositions of pending claims containing tensioning polymers, oil, water and surfactant for treating or softening wrinkled skin.

Response to Arguments

21. Applicant's arguments filed 10/22/09 have been fully considered but they are not persuasive.

22. Applicant argues that the amendment to claims 1 and 33 overcomes the Dubief art and since there is no further art rejection, the provisional obviousness rejection should be withdrawn. But, the provisional obviousness type double patenting rejection is not the only rejection. Since the provisional obviousness type double patenting rejection is not the only rejection in the examined application, the rejection will continue to be made until the rejection is overcome as

stated in MPEP 804 [R-5], I B, that "the "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in at least one of the applications." As noted above, the provisional obviousness double patenting rejection is not the only rejection remaining in this examined application. Thus rejection is maintained and is not held in abeyance.

23. No claim is allowed.

24.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLESSING M. FUBARA whose telephone number is (571)272-0594. The examiner can normally be reached on Monday to Thursday from 7 a.m. to 5:30 p.m.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Blessing M. Fubara/

Primary Examiner, Art Unit 1618